

HOW TO RESPOND TO KIPO WHEN THE APPLICATION IS REJECTED

There are many reasons for rejection of application, but the most two common reasons as follows:

- 1) when the trademark is not distinctive
- 2) when the trademark is distinctive, but cited mark is found before the application.

When the application is rejected because of the first reason, you need to be sure that the trademark you are applying is indeed not distinctive. Because the examiner could be mistaken as a person. A trademark with no distinctive is defined in Article 6 (1) of the Trademark Act, which refers to the generic name of a good and a technical mark, significant geographical names, and simple and common marks. In many cases, however, it is difficult to overcome the reason for rejection if it is due to distinctiveness. It is pointless to insist that a trademark is distinctive because the examiner would know better whether it is distinctive or not. Of course, you may overcome the rejection if you have a plausible ground for asserting that your mark is distinctive. However, it is very difficult to overcome the reason for not being distinctive.

If you do not have a distinctive identity and you still want to register the trademark, you can apply for a new application in conjunction with another distinctive mark. In other words, if you combine a distinctive design with a non-distinctive design, you will be able to register because of its distinctive part. Since not all of the composition of a trademark is required to be discriminative, only a part of the trademark can be registered as a trademark, including an unidentified mark in this way, as the whole is considered to be discriminatory. However, it should be noted that the effect of the registered trademark is limited to the distinctive design. The fact that an unidentified mark is registered in conjunction with a distinctive design does not necessarily lead to exclusive rights to the unidentified portion.

When the application is rejected because of the second reason, you need to examine whether the two trademarks are similar and whether the designated goods and service are similar to the proceeding trademark. Sometimes, due to the error of the examiner, rejection may be notified even though the classifications are different. In such a case, the application may be registered by claiming that the registered goods are not similar.

The next thing you can do is to review whether the cited trademark has any grounds for invalidation or cancellation. As long as there is cited trademark, the later trademark can not be registered in duplicate. The Trademark Law stipulates that if a registered trademark is not used for more than three years after the trademark registration, the trademark may be canceled. Therefore, if the cited trademark is no longer used for three years on the basis of the request for cancellation, you can cancel the cited trademark and register your trademark by requesting a non-use cancellation judgment.